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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/993,054	11/06/2001	Merrit N. Jacobs	CDS-255	9036
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27777 7590 03/02/2006

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EXAMINER
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GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

<b>Application No.</b> 09/993,054	<b>Applicant(s)</b> JACOBS ET AL.	
<b>Examiner</b> Brian R. Gordon	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 12-23-05.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 19-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 19-22 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed December 23, 2006 have been fully considered but they are not persuasive. Applicant asserts the claims are directed to a probe and probe tip while the device of Byrd is a pipette. Applicant is allowed to reference any of the elements by any name so desired. The name of the element does not define its structure. As such the examiner asserts the tube 1 (probe tip) in combination with tube 3 (probe) is structurally equivalent to the combination as claimed.

Applicant provides a detailed description of how one may use the device of Byrd and how one intends to use the claimed device and the desired affects that may occur during the use of the respective devices. The method of mixing is directed to an intended use of the device.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

While applicant asserts the claimed invention allows for a particular motion of mixing. Such a mixing motion is not strictly dependent on the dimensions of the probe tip. Other factors such as the speed of aspiration/dispensing, internal pressure of tube, type fluid being dispensed/aspirated (viscosity, density, etc.) as well as other environmental factors will determine how and if such a mixing will occur.

As previously stated above the examiner asserts the device of Byrd is structurally equivalent to the invention as claimed. Furthermore, while the intended method of use

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and results are not issue, the examiner asserts the device of Byrd may be used to provide for mixing.

For reasons given herein, the examiner hereby maintains the previous rejections as specified.

### ***Claim Interpretation***

1. The examiner notes the rotational motion of aspirated liquid caused by the varying diameters is a rotational motion in the vertical direction (figs. 2A-2C) not horizontally as commonly seen in washing machines, blenders, etc.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Byrd US 1,547,562.

Byrd discloses a pipette assembly that comprises a tube (probe) attached to a variously-diametered pipette tip. As seen the figures the device structurally equivalent to that as claimed by applicant. The diameter of the diluting chamber 9 is used for agitation and appears to be at 3 times the diameter of the adjacent chambers.

### ***Claim Rejections - 35 USC § 103***

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4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd.

Byrd does not disclose the tip portion as a being configured as having the middle cavity being formed of removably mounted elements.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the tip portion may be manufactured to be assembled in multiple parts. It is conventionally known in the art that pipette tips may be manufactured to be disposable (prevention of cross contamination) as well as multiple pieces allow for ease of cleaning the device and ease of replacing parts rather than the entire device if only a portion is of the device is defective.

#### ***Conclusion***

6. No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be the initials 'ERM' in a cursive, stylized font.

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